

**REMARKS****I. General**

Claims 1-20 were pending in the present application and were rejected in the current Office Action (mailed February 9, 2005). The outstanding issues in the current Office Action are:

- A new Declaration is requested to identify parent application, and specification is requested to be amended to identify the parent application;
- Claims 5, 11, and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
- Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,732,156 to Miloslavsky (hereinafter "*Miloslavsky*") in view of U.S. Patent No. 6,757,830 issued to Tarbotton et al. (hereinafter "*Tarbotton*").

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the remarks presented herein.

**II. New Declaration**

As requested by the current Office Action, a new declaration is provided herewith that identifies the parent application, and the specification is amended to provide the serial number of the parent application.

**III. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 5, 11, and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

With regard to claim 5, the Office Action asserts "it is not seen how the steps recited therein are related to routing email messages recited in parent claim 1", *see* page 2 of Office Action. Claim 5 depends from claim 1 and recites "said user submitting information to a web server; and said web server creating an email message to communicate the submitted

information to said first server.” Thus, claim 5 is directed to how the email message comes into existence. That is, the user submits information to a web server and the web server creates the email message to communicate the submitted information to the first server, where claim 1 recites “executing software on said first server to autonomously route said email message to the selected email server.” Thus, Applicant respectfully submits that claim 5 and its relationship to claim 1 is sufficiently clear in accordance with the requirements of 35 U.S.C. § 112, second paragraph. Therefore, withdrawal of this rejection is requested.

With regard to claim 11, the Office Action asserts that it “contradicts with parent claim in that parent claim requires routing without human intervention”, *see* page 2 of Office Action. Applicant fails to see any such contradiction in the language of claim 11. Claim 11 recites in part “wherein said characteristic information of said user includes identification of at least one language of said user”. This language of claim 11 does not address routing of the email, but instead further recites what the characteristic information of the user may include. Therefore, it raises no contradiction with regard to the elements recited in claim 1. Claim 11 further recites “wherein said characteristic associated with the selected email server includes the selected email server having personnel assigned thereto that are capable of communicating in a language common to said at least one language of said user.” This further language of claim 11 also does not address routing of the email, but instead further recites what the characteristic associated with a selected email server may include. Nothing in the language of claim 11 is in contradiction with routing of an email without human intervention. Therefore, claim 11 raises no contradiction with regard to the elements recited in claim 1. As such, Applicant respectfully submits that claim 11 is sufficiently clear and is not in contradiction with claim 1, and thus complies with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of this rejection is requested.

With regard to claim 14, the Office Action asserts: “parent claim 1 recites that the characteristic information of a user is included in the email message. Therefore it is not seen how the web server is related to selecting an e-mail server.” *See* page 2 of Office Action. Claim 1 recites “executing software on said first server to autonomously determine characteristic information of a user having submitted information included in said email message”. Claim 14 further recites “wherein said characteristic information of said user includes information conveyed to a web server from said user.” As described in the

specification of the present application, a web server may receive information from a user, and such received information may form the characteristic information used for routing, *see e.g.* page 9, line 25 – page 10, line 1 of the present application. For instance, a web server may receive information from a user and create the email that is sent to the first server, wherein the created email may include certain “characteristic information” received by the web server. Thus, claim 14 recites that the characteristic information includes information that is conveyed to a web server from the user. Accordingly, Applicant respectfully submits that claim 14 and its relationship to claim 1 is sufficiently clear in accordance with the requirements of 35 U.S.C. § 112, second paragraph. Therefore, withdrawal of this rejection is requested.

#### **IV. Rejections Under 35 U.S.C. § 103(a)**

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miloslavsky* in view of *Tarbotton*. Applicant respectfully traverses this rejection as set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the applied reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied references must teach or suggest all the claim limitations. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the first and third criteria. That is, the combination of *Miloslavsky* and *Tarbotton* fails to teach or suggest all the claim limitations, and no suggestion or motivation is found for modifying their teachings in the manner necessary for achieving the claim limitations.

#### **Independent Claims 1 and 15**

##### *i. Applied Combination Fails to Teach or Suggest All Limitations*

Independent claim 1 recites in part “receiving an email message at a first server; ... executing software on said first server to autonomously select an appropriate one of a plurality of distributed email servers for receipt of said email message based at least in part on said determined characteristic information of said user; and executing software on said

first server to autonomously route said email message to the selected email server” (emphasis added). Similarly, independent claim 15 recites in part “processor for executing said software code to autonomously determine characteristic information of a user having submitted information included in said email message received via said communicative coupling, for executing said software code to autonomously select an appropriate one of a plurality of distributed email servers for receipt of said email message based at least in part on the determined characteristic information of said user, and for executing said software code to autonomously route said email message to the selected email server” (emphasis added). The combination of *Miloslavsky* and *Tarbotton* fails to teach or suggest these elements of claims 1 and 15, as discussed further below.

*Miloslavsky* does not teach or suggest a plurality of distributed email servers. Instead, *Miloslavsky* teaches an email processing center 100 that includes a single email server 102. Thus, *Miloslavsky* does not teach or suggest autonomously selecting an appropriate one of a plurality of distributed email servers for receipt of an email message, and *Miloslavsky* does not teach or suggest autonomously routing the email message to the selected email server. Rather, *Miloslavsky* teaches a system that addresses routing of an email to an appropriate one of a plurality of support personnel that are all coupled to a single email server (server 102 of FIG. 1 of *Miloslavsky*). Indeed, the technique of *Miloslavsky* could be applied in conjunction with embodiments of the present invention. For instance, once the email is routed to the appropriate email server (according to embodiments of the present invention) the technique of *Miloslavsky* may be applied for routing the email received by the email server to a particular support person connected to the email server.

*Miloslavsky* is not concerned with a situation in which a plurality of distributed email servers exist, and *Miloslavsky* does not teach or suggest how an email is routed to one of a plurality of distributed email servers. Rather, *Miloslavsky* merely addresses how to route an email that is received at a particular email server to one of a plurality of support persons connected to such email server. In no instance does *Miloslavsky* suggest that based on a determined appropriate support person being located in a different location the email may be routed to a different email server.

The current Office Action concedes that *Miloslavsky* fails to teach or suggest a probably a distributed e-mail servers, *see* page 3 of the Office Action. However, the current

office action asserts that *Tarbotton* teaches that all e-mail recipients require recipient mail servers in order to receive e-mails. Thus, the current office action concludes that "If the support persons in *Miloslavsky* are located in different remote area, it would have been the obvious to a person of ordinary skill in the art to incorporate more e-mail servers as taught by *Tarbotton* because otherwise the support persons would not be able to receive e-mails." Page 4 of the Office Action. Applicant disagrees, as discussed further below.

*Tarbotton* does not teach or suggest that each e-mail recipient is required to have a separate e-mail server in order to receive e-mails. While FIG. 1 of *Tarbotton* shows a recipient email server 12 and a recipient 4 connected thereto, *Tarbotton* does not teach that a separate email server 12 need be implemented for each individual person, such as each support person in the system of *Miloslavsky*. Rather, as is well known in the art, many persons may be supported by a single email server. Indeed, the system of *Miloslavsky* is implemented such that multiple support persons are connected to a single email server. Nothing and *Tarbotton* precludes a plurality of persons being connected to e-mail server 12. Thus, *Tarbotton* does not teach or suggest that each e-mail recipient is required to have a separate e-mail server in order to receive e-mails. Thus, the combination of *Miloslavsky* and *Tarbotton* does not teach or suggest that separate email servers be implemented for separate support persons, but rather as specifically taught by *Miloslavsky* the support persons are all coupled to a single email server.

In view of the above, the combination of *Miloslavsky* and *Tarbotton* does not teach or suggest all elements of claims 1 and 15, and therefore claims 1 and 15 are not obvious under 35 U.S.C. § 103(a) over this combination.

*ii. No Motivation to Modify the Combination for Achieving the Claim Limitations*

As discussed above, the current office action concedes that *Miloslavsky* does not teach a plurality of distributed e-mail servers. However, the office action appears to assert that it would have been obvious to implement separate e-mail servers for each of the support personnel. For instance, the office action contends "If the support persons in *Miloslavsky* are located in different remote area, it would have been the obvious to a person of ordinary skill in the art to incorporate more e-mail servers as taught by *Tarbotton* because otherwise the

support persons would not be able to receive e-mails" (emphasis added). Page 4 of the Office Action. Applicant disagrees, as discussed below.

As discussed above, *Tarbotton* does not require separate e-mail servers for each recipient. Further, merely because support persons may be located in different remote areas does not require separate e-mail servers for those persons to be able to receive e-mails. For instance, support persons could access an e-mail server from a remote location for retrieving e-mails from such e-mail server. Thus, even if the support persons in *Miloslavsky* were located remote from e-mail server 102, such support persons could still access e-mail server 102 via communication network 128. Accordingly, the motivation recited in the current office action is improper because separate e-mail servers would not be required for support personnel to be able to receive e-mails even if the support personnel were located in different remote areas.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, *see* M.P.E.P. § 2143.01. Additionally, the prior art must suggest the desirability of the claimed invention, *see* M.P.E.P. § 2143.01. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). Further, it is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. *See Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294 (Fed. Cir. 1997).

As discussed above, no proper motivation for modifying the applied references to achieve the claim elements, particularly a plurality of distributed email servers, has been provided by the current Office Action. Therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Additionally, it is not clear if/how a plurality of distributed email servers could be implemented in *Miloslavsky* without changing its principle of operation. For instance,

*Miloslavsky* teaches that processing center 100 includes email server 102 for receiving emails sent to an address associated with it, such as support@abc-company.com, *see* col. 3, lines 7-14 of *Miloslavsky*. *Miloslavsky* further teaches at column 5, lines 21-32:

Processing center 100 contains a number of computer terminals, such as computers 122 and 124, managed by support persons. When a support person starts 15 to work, he/she logs in so that stat-server 112 knows who is working in center 100 and how to reach the support person. Router 116 obtains information to make selection decisions from stat-server 112 and database 114. Once a decision is made, router 116 sends a command to email server 102 to route the e-mail to the selected computer terminal. The support person responds to the e-mail and sends the reply to e-mail server 102, which delivers the reply to the sender via data network 104.

In view of the above, email server 102 receives emails and is coupled with stat-server 112 and router 116 to determine which of the support persons that are logged on each email received by the email server 102 is to be directed. It is unclear if/how such a system could be implemented with separate email servers implemented for each support person. For instance, would the email servers merely be duplicative for storing the same emails, and if so then why would such separate email servers be desired? Further, it is unclear how the stat-server and router would interact with the various email servers if more than one were implemented. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *See* M.P.E.P. § 2143.01, citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959). As described above, it is unclear how a plurality of email servers could be implemented in *Miloslavsky* without changing the inter-operation of the stat-server, router and various other components of *Miloslavsky's* system.

In view of the above, claims 1 and 15 are not obvious under 35 U.S.C. § 103(a) because proper motivation for combining/modifying the references has not been provided. Accordingly, the rejection of claims 1 and 15 should be withdrawn.

### **Independent Claim 19**

*i. Applied Combination Fails to Teach or Suggest All Limitations*

Independent claim 19 recites:

plurality of distributed email servers of an entity communicatively coupled to a communication network;  
web server communicatively accessible by at least one processor-based device, said web server executing software thereon to present an interface for said entity to a user accessing said web server via said at least one processor-based device, wherein said interface enables said user to interact therewith to convey information to said entity; and  
at least one of said web server and said plurality of geographically distributed email servers executing software to autonomously route information conveyed to said entity from said user as an email message to a selected one of said plurality of distributed email servers determined to be appropriate for handling of said email message” (emphasis added).

The combination of *Miloslavsky* and *Tarbotton* fails to teach or suggest these elements of claim 19, as discussed further below.

As described above with claims 1 and 15, *Miloslavsky* does not teach or suggest a plurality of distributed email servers. Instead, *Miloslavsky* teaches an email processing center 100 that includes a single email server 102. Additionally, *Tarbotton* does not teach or suggest that each e-mail recipient is required to have a separate e-mail server in order to receive e-mails. While FIG. 1 of *Tarbotton* shows a recipient email server 12 and a recipient 4 connected thereto, *Tarbotton* does not teach that a separate email server 12 need be implemented for each individual person, such as each support person in the system of *Miloslavsky*. Thus, contrary to the assertion of the present Office Action, the combination of *Miloslavsky* and *Tarbotton* does not teach or suggest implementing a recipient email server for each support person in the system of *Miloslavsky*. Thus, the combination of *Miloslavsky* and *Tarbotton* does not teach or suggest all elements of claim 19, and therefore claim 19 is not obvious under 35 U.S.C. § 103(a) over this combination.

Further, neither *Miloslavsky* nor *Tarbotton* teach or suggest a web server executing software thereon to present an interface to a user that enables the user to interact therewith to convey information to the entity. Also, neither *Miloslavsky* nor *Tarbotton* teach or suggest routing information conveyed to the entity from a user (via a web server’s interface) as an email message to an email server. That is, neither *Miloslavsky* nor *Tarbotton* teach or suggest a system in which a user interacts with a web server to supply information, wherein such information is conveyed as an email to an appropriate email server. Rather, in *Miloslavsky*

and *Tarbotton* a sender composes an email and directs it to an intended recipient email addresses without interacting with a web server's interface. Thus, the combination of *Miloslavsky* and *Tarbotton* does not teach or suggest all elements of claim 19, and therefore claim 19 is not obvious under 35 U.S.C. § 103(a) over this combination.

*ii. No Motivation to Modify the Combination for Achieving the Claim Limitations*

As discussed above with claims 1 and 15 proper motivation for combining/modifying the *Miloslavsky* and *Tarbotton* references has not been provided. Accordingly, the rejection of claim 19 should be withdrawn.

**Dependent Claims**

Each of dependent claims 2-14, 16-18, and 20 depend either directly or indirectly from one of independent claims 1, 15, and 19, and thus inherit all limitations of the respective independent claim from which they depend. It is respectfully submitted that dependent claims 2-14, 16-18, and 20 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

For example, dependent claim 2 depends from claim 1 and further recites "wherein said first server is a web server". Neither *Miloslavsky* nor *Tarbotton* teach or suggest this limitation. The current Office Action merely asserts, regarding claim 2, that "label of servers is not a patentable subject matter." Page 4 of Office Action. Applicant respectfully submits that this language of claim 2 is not a mere "label" of a server, but identifies that the recited "first server" of claim 1 is a "web server", which is a well-known type of server. Again, neither *Miloslavsky* nor *Tarbotton* address a situation in which the first server recited in claim 1 is a web server. Accordingly, the rejection of claim 2 should be withdrawn.

As another example, dependent claim 5 depends from claim 1 and further recites "said user submitting information to a web server; and said web server creating an email message to communicate the submitted information to said first server". In its treatment of claim 5, the current Office Action merely asserts that "state-server 112 in *Miloslavsky* also stores user information." Page 4 of Office Action. It is noted that claim 5 does not recite storing user

information, and thus whether state-server 112 stores user information seems irrelevant to the consideration of patentability of claim 5. Neither *Miloslavsky* nor *Tarbotton* teach or suggest the elements that are recited by claim 5. For instance, neither *Miloslavsky* nor *Tarbotton* teach or suggest a user submitting information to a web server and a web server creating an email message to communicate the submitted information.

As still a further example, claim 9 depends from claim 1 and further recites "wherein said executing software on said server to autonomously select an appropriate email server further comprises: selecting said appropriate email server based at least in part on said appropriate email server having a characteristic associated therewith that corresponds to the determined characteristic information of the user." As described above, *Miloslavsky* does not teach or suggest selecting an appropriate email server, but instead teaches a single email server and selects one of a plurality of support personnel that are connected to the email server to whom an email received by the email server should be routed. Further, even if separate email servers were implemented for each support person, as suggested by the current Office Action, nothing in *Miloslavsky* teaches or suggests selecting an appropriate one of such email servers based on such email server having a characteristic associated therewith that corresponds to a determined characteristic information of a user, as recited in claim 9.

## V. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 100200074-1 from which the undersigned is authorized to draw.


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